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10/665,741

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EXAMINER

FRENEL, VANEL

ART UNIT

PAPER NUMBER

3687

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                                      |   |  |
|------------------------------|--------------------------------------|---|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/665,741 | <b>Applicant(s)</b><br>SHIBUNO, MASATSUGU |  |
|                              | <b>Examiner</b><br>VANEL FRENEL      | <b>Art Unit</b><br>3687                   |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10/16/08.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### **Notice to Applicant**

1. This communication is in response to the Amendment filed on 10/16/08. Claim 8 has been cancelled. Claims 1 and 17-18 have been amended. Claims 1-7 and 9-18 are pending.

### ***Claim Rejections - 35 USC § 101***

2. 35 U.S.C. 101 reads as follows:  
Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.
3. Claim 17 is rejected under 35 U.S.C 101 because the claimed invention is directed to non-statutory subject matter.

As per claim 17, the claim recites in the preamble “a computer data signal embedded in a carrier wave”. Examiner notes that “a computer data signal embedded in a carrier wave” may include electrical, electromagnetic, or digital signals, which are not statutory subject matter. See *In re Nuijten*, Docket no. 2006-1371 (Fed. Cir. Sept. 20, 2007) (slip. op. at 18) (“A transitory, propagating signal like Nuijten’s is not a ‘process, machine, manufacture, or composition of matter.’ ... Thus, such a signal cannot be patentable subject matter.”). As such, claim 17 is non-statutory.

### ***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Inoue et al. (7,188,137) in view of Freedman et al. (2004/0249650).

As per claim 1, Inoue discloses a one-to-one business support system comprising: a storage device that stores customer attribute information indicating an attribute of a customer and purchase information indicating a commodity purchased by the customer (See Inoue, Col.8, lines 54-67 to Col.9, line 2); and a server that provides the application program to said client computer (See Inoue, Fig. 11; Col.14, lines 50-67 to Col.15, line 14).

Inoue does not explicitly disclose a client computer that executes an application program to perform a first function of narrowing down a customer who satisfies a predetermined condition based on the customer information stored in said storage device, a second function of deciding a plan of an action that is performed to the customer narrowed down for each customer, a third function of issuing a relation tool for executing the decided plan, and/or a fourth function of performing an evaluation of the action according to a predetermined criterion; and a server that provides the application program to said client computer,” wherein said client computer captures language information indicating words uttered by the customer and presents the language information to an operator in a predetermined form that the operator can recognize”.

However, these features are known in the art, as evidenced by Freedman. In particular, Freedman suggests that the system having a client computer that executes

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an application program to perform a first function of narrowing down a customer who satisfies a predetermined condition based on the customer information stored in said storage device, a second function of deciding a plan of an action that is performed to the customer narrowed down for each customer, a third function of issuing a relation tool for executing the decided plan, and/or a fourth function of performing an evaluation of the action according to a predetermined criterion (See Freedman, Page 4, Paragraph 0038); and a server that provides the application program to said client computer,” wherein said client computer captures language information indicating words uttered by the customer and presents the language information to an operator in a predetermined form that the operator can recognize (See Freedman, Paragraph 0039; Fig.5; Fig.6; Page 15, Paragraphs 0064).

It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the features of Freedman within the system of Inoue with the motivation of providing an apparatus for capturing and analyzing customer interactions the apparatus comprising a multi segment interaction device etc. (See Freedman, Page 3, Paragraph 0015).

As per claim 2, Inoue discloses the one-to-one business support system wherein the application program provided by said server includes a program that causes said client computer to execute a fifth function of creating a script that defines the contents of the relation tool in a personalized form for each customer, and a sixth function of issuing the relation tool by instructing said server to output the relation tool having the contents

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according to the script, wherein said server includes an output device that outputs the relation tool according to the instruction of said client computer (See Inoue, Col.8, lines 38-67; Col.14, lines 64-67 to Col.15, line 14).

As per claim 3, Inoue discloses the one-to-one business support system wherein said server includes a printer that prints the relation tool having the personalized contents for each customer according to an instruction of printing supplied from said client computer (See Inoue, Col.14, lines 26-67).

As per claim 4, Freedman discloses the one-to-one business support system wherein said client computer includes a main office terminal and a shop terminal, and said main office terminal includes an output device that presents at least a part of information used in executing the first to fourth functions to an operator in a recognizable form, and said shop terminal includes an output device that presents at least a part of information used in executing the fifth and sixth functions to an operator in a recognizable form (See Freedman, Page 4, Paragraph 0038; Page 5, Paragraph 0039).

As per claim 5, Freedman discloses the one-to-one business support system, wherein the output device of said shop terminal obtains and/or stores customer attribute information of a customer, information indicating a rank when the customer is ranked on a predetermined criterion, information indicating a commodity purchased by the

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customer in the past and information indicating a history of a relation with the customer, and outputs any one of these information items that confirms to a condition designated by the operator (See Freedman, Page 4, Paragraphs 0038-0040).

As per claim 6, Freedman discloses the one-to-one business support system wherein the action includes any one or more of an action of an event system that encourages the customer to come to the shop to improve sales promotion, an action of a calendar system that deepens the relationship with the customer to make the customer a regular customer to improve customer loyalization and an action of a shop service system that deepens the relationship with the customer at the shop to improve a sales rate or suggest coordinates (See Freedman, Page 7, Paragraphs 0043-0044).

As per claim 7, Freedman discloses the one-to-one business support system wherein the action of the event system includes an action that issues a relation tool that transmits a message to the customer on a one-to-one basis, hereby sending a guide for a sales promotion to the customer, the action of the calendar system includes an action that issues a relation tool according to a calendar preset for each event, and the action of the shop service system includes an action that presents the contents of a personalized script to a person to be served (See Freedman, Page 12, Paragraphs 0059-0060).

As per claim 8, Inoue discloses the one-to-one business support system wherein said client computer captures language information indicating words uttered by the customer and present the language information to an operator in a predetermined form that the operator can recognize (See Inoue, Col.14, lines 49-67 to Col.15, line 14).

As per claim 9, Inoue discloses the one-to-one business support system wherein the relation tool includes at least any one of DM (Direct Mail), facsimile, e-mail, and telephone (See Inoue, Col.28, lines 30-43).

As per claim 10, Inoue discloses the one-to-one business support system wherein the application program provided by said server includes a program that causes said client computer to perform a function of specifying a frequency of which the customer conducts a business transaction at the shop based on the customer attribute information to predict a day when the customer comes to the shop based on the frequency, and a function of detecting an arrival of a predetermined time decided based on the predicted day to perform an output of a message that encourages execution of the action and/or an issue of an relation tool relating to the action (See Inoue, Fig.20; Col.12, lines 4-48; Col.25, lines 34-67; Col.28, lines 5-44).

As per claim 11, Freedman discloses the one-to-one business support system wherein the application program provided by said server includes a program that causes said client computer to perform a function of obtaining purchase information at



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multiple points in time in connection with persons, who are customers at least any of the multiple points in time, to classify the respective customers at the multiple points in time into any of multiple ranks according to a predetermined criterion based on these purchase information and a function of specifying a variation in a customer rank, the number of newly enrolled customers and/or the number of withdrawn customers based on a result of the classification to output information indicating a specified result (See Freedman, Page 15, Paragraph 0064).

As per claim 12, Freedman discloses the one-to-one business support system wherein the application program provided by said server includes a program that causes said client computer to perform a function of extracting a customer according to a predetermined condition based on the customer attribute information and/or purchase information and a function of generating data indicating at least any parameter of the number of extracted customers, a frequency of which the corresponding customer purchases a commodity, a type of a commodity purchased by the corresponding customer, a sales amount per one corresponding customer, the number of purchased commodities per one corresponding customer and a unit price of the commodity purchased by the corresponding customer and data indicating a time transition of the parameter value based on the customer attribute information and/or purchase information (See Freedman, Page 6, Paragraph 0040).

As per claim 13, Inoue discloses the one-to-one business support system wherein said server provides the application program by executing an ASP (Application Service Provider) service (See Inoue, Col.14, lines 50-62).

As per claim 14, Inoue discloses the one-to-one business support system further comprising a card reader that reads customer attribute information and/or purchase information from a magnetic card or an IC (Integrated Circuit) card to obtain the customer attribute information and/or purchase information or a POS (Point OF Sales) register that obtains customer attribute information and/or purchase information according to an operation from an operator, wherein said card reader and said POS register are connected to said storage device via a communication line, and the obtained customer attribute information and/or purchase information is supplied to said storage device and stored therein (See Inoue, Fig.2, Col.13, lines 39-67 to Col.14, line 62).

As per claim 15, Inoue discloses the one-to-one business support system wherein said server includes a web server and the web server provides data to said client computer that functions as a client machine via a network according to a communication procedure where security is ensured (See Inoue, Col.15, lines 4-28).

As per claim 16, Inoue discloses the one-to-one business support system further comprising a database server connected to said storage device via a communication

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line where security is ensured, wherein said database server and said application server are connected to each other via a firewall to form a security capsule zone (See Inoue, Fig.1; Fig.13, Col.15, lines 4-52).

Claim 17 differs from claim 1 by reciting a computer data signal embedded in a carrier wave that indicates a program for causing a computer to function.

As per this limitation, it is noted that Inoue discloses a storage device that stores customer attribute information indicating an attribute of a customer and purchase information indicating a commodity purchased by the customer (See Inoue, Col.8, lines 54-67 to Col.9, line 2) and Freedman discloses a client computer that executes an application program to perform a first function of narrowing down a customer who satisfies a predetermined condition based on the customer information stored in said storage device, a second function of deciding a plan of an action that is performed to the customer narrowed down for each customer, a third function of issuing a relation tool for executing the decided plan, and/or a fourth function of performing an evaluation of the action according to a predetermined criterion and a server that provides the application program to said client computer (See Freedman, Fig.7; Page 4, Paragraph 0038; Page 17, Paragraph 0080), "wherein said client computer captures language information indicating words uttered by the customer and presents the language information to an operator in a predetermined form that the operator can recognize" (See Freedman, Paragraph 0039; Fig.5; Fig.6; Page 15, Paragraphs 0064).

Thus, it is readily apparent that these prior art systems utilize a computer data signal embedded in a carrier wave that indicates a program for causing a computer to perform their specified function.

The remainder of claim 17 is rejected for the same reason given above for claim 1, and incorporated herein.

Claim 18 differs from claims 1 and 17 by reciting a computer-readable storage medium having a program recorded thereon.

As per this limitation, it is noted that Inoue discloses said program causing a computer to function as a storage device that stores customer attribute information indicating an attribute of a customer and purchase information indicating a commodity purchased by the customer (See Inoue, Col.8, lines 54-67 to Col.9, line 2) and Freedman discloses a client computer that executes an application program to perform a first function of narrowing down a customer who satisfies a predetermined condition based on the customer information stored in said storage device, a second function of deciding a plan of an action that is performed to the customer narrowed down for each customer, a third function of issuing a relation tool for executing the decided plan, and/or a fourth function of performing an evaluation of the action according to a predetermined criterion and a server that provides the application program to said client computer (See Freedman, Fig.7; Page 4, Paragraph 0038; Page 17, Paragraph 0080), " wherein said client computer captures language information indicating words uttered by the customer and presents the language information to an operator in a predetermined

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form that the operator can recognize” (See Freedman, Paragraph 0039; Fig.5; Fig.6; Page 15, Paragraphs 0064).

Thus, it is readily apparent that these prior art systems utilize a computer data signal embedded in a carrier wave that indicates a program for causing a computer to perform their specified function.

The remainder of claim 18 is rejected for the same reason given above for claims 1 and 17, and incorporated herein.

### ***Response to Arguments***

6. Applicant's arguments filed on 10/16/08 with respect to claims 1-18 have been fully considered but they are not persuasive.

(A) At pages 1-2 of the response filed on 10/16/08, Applicant's argues the followings:

There is no teaching or suggestion in the cited section of Inoue of a combination in which a client computer captures language information indicating words uttered by the customer and presents the language information to an operator in a predetermined form that the operator can recognize.

(B) With respect to Applicant's first argument, the Examiner respectfully submitted that He relied upon the teaching of Freedman (See Paragraph 0039; Fig.5; Fig.6; Page 15, Paragraphs 0064) which correspond to Applicant claimed feature. Therefore, Applicant argument is not persuasive and the rejection is hereby sustained.

In response to Applicant argument there is no suggestion to combine, the Examiner respectfully submitted that obviousness is determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See *In re Oetiker*, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992); *In re Hedges*, 783 F.2d 1038, 1039, 228 USPQ 685,686 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 USPQ 785,788 (Fed. Cir. 1984); and *In re Rinehart*, 531 F.2d 1048, 1052, 189 USPQ 143,147 (CCPA 1976). Using this standard, the Examiner respectfully submits that he has at least satisfied the burden of presenting a *prima facie* case of obviousness, since he has presented evidence of corresponding claim elements in the prior art and has expressly articulated the combinations and the motivations for combinations that fairly suggest Applicant's claimed invention.

Rather, Applicant does not point to any specific distinction(s) between the features disclosed in the references and the features that are presently claimed. In particular, 37 CFR 1.111(b) states, "A general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the reference does not comply with the requirements of this section." Applicant has failed to specifically point out how the language of the claims patentably distinguishes them from the applied references. Also, arguments or conclusions of Attorney cannot take the place of evidence. *In re Cole*, 51 CCPA 919, 326 F.2d 769, 140 USPQ 230 (1964); *In re Schulze*, 52 CCPA 1422, 346 F.2d 600, 145 USPQ 716 (1965); *Mertizner v. Mindick*, 549 F.2d 775, 193 USPQ 17 (CCPA 1977).

In addition, the Examiner recognizes that references cannot be arbitrarily altered or modified and that there must be some reason why one skilled in the art would be motivated to make the proposed modifications. However, although the Examiner agrees that the motivation or suggestion to make modifications must be articulated, it is respectfully contended that there is no requirement that the motivation to make modifications must be expressly articulated within the references themselves. References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures, *In re Bozek*, 163 USPQ 545 (CCPA 1969).

The Examiner is concerned that Applicant apparently ignores the mandate of the numerous court decisions supporting the position given above. The issue of obviousness is not determined by what the references expressly state but by what they would reasonably suggest to one of ordinary skill in the art, as supported by decisions in *In re DeLisle* 406 Fed 1326, 160 USPQ 806; *In re Kell, Terry and Davies* 208 USPQ 871; and *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ 2d 1596, 1598 (Fed. Cir. 1988) (citing *In re Lalou*, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1988)). Further, it was determined in *In re Lamberti et al*, 192 USPQ 278 (CCPA) that:

- (i) obviousness does not require absolute predictability;
- (ii) non-preferred embodiments of prior art must also be considered; and
- (iii) the question is not express teaching of references, but what they would

suggest. Therefore, Applicant argument is not persuasive and the rejection is hereby sustained.

**7. THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

### **Conclusion**

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to VANEL FRENEL whose telephone number is (571)272-6769. The examiner can normally be reached on 6:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Matthew S. Gart can be reached on 571-272-3955. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call



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800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Vanel Frenel/

Examiner, Art Unit 3687

December 29, 2008

/Matthew S Gart/

Supervisory Patent Examiner, Art Unit 3687